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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/500,601	02/08/2000	Enrique David Sancho	A-363-I US	2846
7590	05/05/2004		EXAMINER	
Thomas A. O'Rourke Bodner & O'Rourke 425 Broadhollow Road Melville, NY 11747			WINTER, JOHN M	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/500,601	SANCHO, ENRIQUE DAVID	
Examiner	Art Unit		
John M Winter	3621		MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 13 February 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 16-39 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 16-39 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 3, 5-9, and 13-15 are drawn to secure transaction utilizing a third party (the security server), classified in class 705 subclass 78.
  - II. Claims 4 and 10-12, drawn to secure transactions utilizing transaction verification, classified in class 705 subclass 75.
  - III. Claims 16-39, drawn to secure transactions utilizing PIN verification, classified in class 705 subclass 72.
  - IV. Claims 40-49, drawn to authenticating users 705 subclass 67.

Inventions I,II, III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a third party is not necessary for user authentication. The subcombination has separate utility such as utilizing a third party.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Examiner notes that it would be a serious burden to search all seven inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via paper 14 file on February 13,2004 the Applicant has elected the examination of invention III, directed towards claims 16-39. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3-15 and 40-49 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 16-39 have been examined.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padgett et al (US Patent 6,167,518) in view of Ross (US Patent 6,195,447).

As per claim 16,

Padgett et al ('518) discloses a method for verifying a user and a user computer comprising:

in response to the request for verification, sending at least one request to the user computer; (Figure 1)

comparing the first identification for the user against a second identification for the user to verify the user, the second identification for the user accessible by the verification computer; (Column 2, lines 61-67; column 3 lines 1-6)

Padgett et al ('518) does not explicitly disclose the features of receiving a request for verification from a computer; receiving at least one response from the user computer, the at least one response including a first fingerprint file and a first identification for the user; comparing the first fingerprint file against a second fingerprint file to verify the user computer, the second fingerprint file accessible by the verification computer; sending at least one verification response, based upon the comparing of the first fingerprint file against the second fingerprint file and upon the comparing of the first identification for the user against the second identification for the user. Ross ('447) discloses receiving a request for verification from a computer; receiving at least one response from the user computer, (Figure 3) the at least one response including a first fingerprint file and a first identification for the user; (Column 3, lines 56-59) comparing the first fingerprint file against a second fingerprint file to verify the user computer, the second fingerprint file accessible by the verification computer; (Column 4, lines 1-7); sending at least one verification response, based upon the comparing of the first fingerprint file against the second fingerprint file and upon the comparing of the first identification for the user against the second identification for the user. (Column 4, lines 25-27) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Padgett et al ('518) method with the Ross ('447) method in order to increase security in systems that utilize fingerprint comparisons without requiring additional hardware costs.

As per claim 17,

Padgett et al ('518) discloses the method according to claim 16

Padgett et al ('518) does not explicitly disclose the verification computer is a clearinghouse computer. Ross ('447) discloses the verification computer is a clearinghouse computer. (Figure 3) It would have been obvious to one having ordinary skill in the art at the

time the invention was made to combine the Padgett et al ('518) method with the Ross ('447) method in order to increase security in systems that utilize fingerprint comparisons without requiring additional hardware costs.

As per claim 18,

Padgett et al ('518) discloses the method according to claim 16

Padgett et al ('518) does not explicitly disclose the verification computer is a vendor computer. Ross ('447) discloses the verification computer is a vendor computer.(Figure 3) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Padgett et al ('518) method with the Ross ('447) method in order to increase security in systems that utilize fingerprint comparisons without requiring additional hardware costs.

As per claim 19,

Padgett et al ('518) discloses A method according to claim 16, wherein said step of sending at least one request to a user computer includes:

sending a first request to the user computer for the first fingerprint file; and sending a second request to the user computer for the first identification for the user.(Column 5, lines 16-26, Figure 2)

As per claim 20,

Padgett et al ('518) discloses a method according to claim 16, wherein said step of receiving at least one response from the user computer includes:

receiving a first response from the user computer including the fingerprint file; and receiving a second response from the user computer including the first identification for the user.(Column 5, lines 43-44)

As per claim 21,

Padgett et al ('518) discloses a method according to claim 16,

Official Notice is taken that "the second response from the user computer is received prior to first response from the user computer" is common and well known in prior art in reference to network communications. It would have been obvious to one having ordinary skill in the art at the time the invention was made that replies from a client might be received out of order because of the nonhomogenous nature of computer networks, ie. The first response could be delayed due the a large amount of network traffic while the second response might be routed differently and be received prior to the first transmission. The Examiner noted that this feature is common to Email systems such as SMTP.

As per claim 22,

Padgett et al ('518) discloses a method according to claim 16,

Official Notice is taken that "steps of comparing the first fingerprint file against a second fingerprint file, and comparing the first identification for the user against a second identification for the user are not performed simultaneously" is common and well known in prior art in reference to authentication via database. It would have been obvious to one having ordinary skill

in the art at the time the invention was made that comparison of identification feature would not occur simultaneously in order to provide more efficient processing of the data, by comparing the fingerprint files sequentially processing time is save if the first comparison fails, rendering the second comparison unnecessary

As per claim 23,

Padgett et al ('518) discloses a method according to claim 18, wherein said step of sending at least one response to the vendor computer, based upon the comparing of the first fingerprint file against the second fingerprint file and upon the comparing of the first identification for the user against the second identification for the user includes

sending a confirmation only when both the first fingerprint file and the first identification of the user match the second fingerprint file and the second identification for the user respectively.(Column 6, lines 40-49)

As per claim 24,

Padgett et al ('518) discloses a method according to claim 19, wherein said step of receiving at least one response from the user computer includes:

receiving a first response from the user computer including the first fingerprint file; and receiving a second response from the user computer including the first identification for the user.(Figure 2)

As per claim 25,

Padgett et al ('518) discloses a method according to claim 24,

Official Notice is taken that "the second response from the user computer is received prior to first response from the user computer" is common and well known in prior art in reference to network communications. It would have been obvious to one having ordinary skill in the art at the time the invention was made that replies from a client might be received out of order because of the non- homogenous nature of computer networks, ie. The first response could be delayed due the a large amount of network traffic while the second response might be routed differently and be received prior to the first transmission. The Examiner noted that this feature is common to Email systems such as SMTP.

As per claim 26,

Padgett et al ('518) discloses a method according to claim 16,

wherein the first identification for the user includes a password.(Column 5, lines 13-22)

As per claims 27 and 28,

Padgett et al ('518) discloses a method according to claim 16,

Official Notice is taken that "the first fingerprint file includes information based upon an identification number of a CPU [or MAC address]of the user computer" is common and well known in prior art in reference to authentication. It would have been obvious to one having ordinary skill in the art at the time the invention was made that a hardware identifier such as a CPU ID or MAC address would be included along with a users identity in order to increase the security of the system by preventing access from unauthorized locations.

As per claim 29,

Padgett et al ('518) discloses a method according to claim 16, wherein prior to the step of receiving the first request from the verification computer,

storing the second fingerprint file in a first data base accessible by verification computer, and storing the second identifications for the user in a second database accessible by the verification computer.(Figure 3)

As per claim 30,

Padgett et al ('518) discloses a method according to claim 18, wherein prior to the step of receiving the first request from the vendor computer,

storing the second fingerprint file in a first data base accessible by a clearinghouse computer, and storing the second identifications for the user in a second database accessible by a clearinghouse computer.(Figure 3)

As per claim 31,

Padgett et al ('518) discloses the method according to claim 28

Official Notice is taken that "first database and second database are the same" is common and well known in prior art in reference to authentication. It would have been obvious to one having ordinary skill in the art at the time the invention was to not use multiple databases in order to increase the performance of the system by reducing the number of database transactions made

As per claim 32,

Padgett et al ('518) discloses the method according to claim 18 wherein the step of receiving a request from a vendor computer includes

receiving an Internet address of the user computer.(Figure 3)

As per claim 33,

Padgett et al ('518) discloses the method according to claim 32

Official Notice is taken that "identifying the user computer based upon the Internet address received from the vendor computer" is common and well known in prior art in reference to authentication. It would have been obvious to one having ordinary skill in the art at the time the invention was made that a identifier such as an Internet address would identify the user in order to increase the security of the system by preventing access by unauthorized people.

As per claim 34,

Padgett et al ('518) discloses a clearinghouse computer comprising:

a processor for communicating with the storage unit and the memory unit for comparing information indicative of the second fingerprint file and the second identification for the user with information indicative of the first fingerprint file and first identification for the user, and causing a message to be generated based upon the comparing.(Column 2, lines 61-67; column 3 lines 1-6). Padgett et al ('518) does not explicitly disclose a storage unit for storing information received from a user computer; the information including a second fingerprint file and a second

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identification for a user; a memory unit for receiving information indicative of first fingerprint file and a first identification for the user; Ross ('447) discloses a storage unit for storing information received from a user computer;(Figure 3) the information including a second fingerprint file and a second identification for a user;(Column 3, lines 56-59) a memory unit for receiving information indicative of first fingerprint file and a first identification for the user(Column 3, lines 56-59). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Padgett et al ('518) method with the Ross ('447) method in order to increase security in systems that utilize fingerprint comparisons without requiring additional hardware costs.

As per claim 35,

Padgett et al ('518) discloses a clearinghouse computer according to claim 34, wherein the storage unit includes:

a first storage location for storing the second fingerprint file, and a second storage location for storing the second identification for the user.(Figure 3)

As per claim 36,

Padgett et al ('518) discloses a clearinghouse computer according to claim 34, wherein the memory unit includes:

a first memory location for storing, at least temporarily, the first fingerprint file, and a second memory location for storing, at least temporarily, the first identification for the user.(Figure 3)

As per claim 37,

Padgett et al ('518) discloses a clearinghouse computer according to claim 34, further including:

an output for receiving the message to be generated based upon the comparison, and the output further capable of communicating with a vendor computer.(Figure 8)

As per claim 38,

Padgett et al ('518) discloses a clearinghouse computer according to claim 34, wherein the second identification for the user includes a password.(Column 5, lines 13-22)

As per claim 39,

Padgett et al ('518) discloses a clearinghouse computer according to claim 34

Official Notice is taken that "includes information based upon an identification number of a CPU of the user computer" is common and well known in prior art in reference to authentication. It would have been obvious to one having ordinary skill in the art at the time the invention was made that a hardware identifier such as a CPU ID would be included along with a users identity in order to increase the security of the system by preventing access from unauthorized locations.

***Conclusion***

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (763) 872-9306 for regular communications and (763) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW  
May 2, 2004

  
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